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EXAMINER

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ART UNIT

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/966,027
Filing Date: September 28, 2001
Appellant(s): NIELSEN, PAUL

Paul Nelson
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed Dec. 10, 2007 appealing from the Office
action mailed July 1, 2007

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

Estes, US Patent 6,508,398 Jan. 21, 2003

Mishkin, Frederic, Book "the Economics of Money, Banking, and Financial Markets"

(9) Grounds of Rejection

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The following ground(s) of rejection are applicable to the appealed claims. This is a verbatim copy of the final rejection mailed on July 1, 2007.

Claim Rejections - 35 USC § 103

The Examiner has read and reviewed all of the information provided by the Applicant. The examiner rejects as final claims 31-41 under 35 USC 103.

The Applicant attention is re-drawn to the following:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 31-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Estes (U.S. Patent 6,508,398) in view of Mishkin (book "The Economics of Money, banking, and financial markets" page 105-109)

Claims 31:

Method of operating an ATM comprising:

a) charging customers for services rendered by the ATM (*the examiner claims official notice that ATMs charge fees*)

b) predicting a time when usage of the ATM by customer will increase (*see Estes, column 1, line 46 "monitor"*)

Although Estes does not have "increasing charges at ATM during said times", Mishkin claims "supply and demand curve." The concept of a Supply and Demand curve is so well known the examiner considered using Official Notice. The examiner acknowledges this particular reference is referring to interest rate but clearly it applies to any item and certainly a commodity like ATM fees. It is a very well known concept in Economics and Marketing that the higher the demand (in this case more usage of ATM) the higher a price one can charge. This concept has been used for centuries – charge more for phone calls at peak time or airline tickets or whatever is in demand. Applying this to ATM charges is clearly obvious.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to add “supply and demand curve” as taught in Mishkin to Estes.

It is clear that one would be motivated to capture the highest possible revenue.

Claims 32:

Time coincides with public events occurring near the ATM

The examiner argues Office Notice that it is well known to one of ordinary skill in the art at the time of the invention that a public event will mean more people and more people will mean more potential ATM users.

Claims 33 & 36 & 37 & 38 & 39 & 40 & 41:

ATM send performance data to a server for every transaction including type and time of occurrence. (see *Estes*, column 1, line 46 “monitor” & column 2, line 25-58, “monitor .. the transactions”)

Claims 34:

ATM responds to commands for altering operation of ATM (see *Estes*, Figure 1 item 28)

Claims 35:

A) transmitting performance data (see *Estes*, column 2, line 25-58)

B) Analyzing the data (see *Estes*, column 2, line 25-58)

Examiner Comments

At the end of the day this case is about applying basic 101 marketing and economic principals to an ATM transaction. Any freshman in college would understand and apply these basic principals. Nothing novel is happening with in the ATM (hence the *Estes*) and nothing novel is happen with the pricing (hence the *Mishkin*). Either the

applicant needs to significant change the claims toward a part of this invention that is novel or I would recommend abandoning this case altogether.

(10) Response to Argument

Argument for Independent Claim 31 and its Dependent Claims 32-41

Appellant argues Reason 1 “Estes does not monitor”

The examiner refutes these arguments and draws attention to Column 2, line 36-37 “The ATM enhancement processor can therefore monitor and record the transactions.”

Appellant argues motivation of “capture the highest possible revenue.”

The examiner refutes these arguments and draw the attention to KSR.

Appellants’ pre-KSR brief argues that there is not teaching suggestion or motivation to combine references. KSR forecloses Appellant’s argument that a specific teaching is required for a finding of obviousness. KSR, 127 S.Ct. at 1741, 82 USPQ2d at 1396. Claims 31-41 recite combinations which only unite old elements with no change in their respective functions and which yield predictable results. Thus, the claimed subject matter likely would have been obvious under KSR.

Just for the record since the attorney believes the board were be persuaded because the attorney holds a BA in economics from Northwestern the examiner would like to mention that she has spent the majority of her career in business and holds a MBA from Duke University.

The appellant spent a lot of time arguing the motivation of combining Estes and Miskins - as expressed above in light of KSR the motivation is moot however the examiner would like to explain how the business concept of the appellant is well know with the basic supply demand curve provided of Miskins. The appellant argued between point A and point E (see Miskins Figure 1). However in the applicant’s example of the ATM if there was increase demand (such as a “public

event" in claim 32) the demand curve (B_d) would actually shift to the right increasing the price a customer is willing to pay. He is correct that "profit is maximized when marginal revenue equals marginal costs." Any business would want to capture the "marginal revenue" from the "increase in price a customer is willing to pay" on the "supply-demand curve." In the case of the ATM the initial capital investment into the actually machine is a fixed cost and a sunk costs and the marginal cost is almost zero, cost of paper, maintenance, etc.

The appellant argues the "gist" of the examiner.

The examiner refutes the argument of the applicants as the examiner did address every limitation of the claims. The examiner added this examiners remark to summarize her argument and emphasize her belief that the "supply-demand curve" business concept is well know and used in many industries. The examiner would like to reiterate how these examples are very applicable example of the supply-demand curve at in industrial applications. The examiner believes the airline industry example is very applicable. It is described below in how the "supply-demand curve" business concept (see "variations in elasticity of demand") is used in the airline industry:

Airlines are expert at practising this form of yield management, extracting from consumers the price they are willing and able to pay for flying to different destinations are various times of the day, and exploiting variations in elasticity of demand for different types of passenger service. You will always get a better deal / price with airlines such as EasyJet and RyanAir if you are prepared to book weeks or months in advance. The airlines are prepared to sell tickets more cheaply then because they get the benefit of cash-flow together with the guarantee of a seat being filled. The nearer the time to take-off, the higher the price. If a businessman is desperate to fly from Newcastle to Paris in 24 hours time, his or her demand is said to be price inelastic and the corresponding price for the ticket will be much higher.

As described in the last office action it is also used in the telephone or electricity industry where there are different fees for different times. A more recent business example would be internet cafes that charge a different price based on how many computers are being used which changes dynamically.

If this paragraph was the only evidence provide in the examiners answer it would not be sufficient but as addition explanation of how the business concept of

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"supply-demand curve" is used the examiner believes it is a helpful example and should remain on the record and consideration for the board.

In summary, while the examiner actually applauds the company for applying these well known business concept of "supply-demand curve" to an ATM as good business practice it is not a novel idea or concept and there for not patentable.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.
Respectfully submitted,

/Kirsten Sachwitz Apple/
Examiner
Art Unit 3693

Conferees:

James Trammell, SPE

/James P Trammell/

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Mary Cheung, Primary

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